

## 14 Collective marks

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### 1. Introduction

Collective trade marks (collective marks) indicate the commercial origin of goods or services just as standard trade marks do, but as collective marks they indicate origin in members of an association rather than origin in one party. The Trade Marks Act 2002 (the Act) allows for the registration of a collective mark by including a collective mark within the definition of trade mark.

Sections 7(1)(d) and 10(2) of the Act provide for additional rights that attach to registered collective marks.

Section 15 of the Act provides additional provisions that relate to the registrability of collective marks.

Sections 101 and 107 of the Act provide for additional infringement rights and damages.

Regulation 59 of the Trade Mark Regulations 2003 (the Regulations) sets out the application requirements for collective marks.

### 2. Collective trade marks

A collective mark is a sign used, or intended to be used, in relation to goods produced or services provided in the course of trade by members of an association to distinguish those goods produced or services provided by persons who are not members of the association. This differs from a standard trade mark registration whose function is to distinguish the goods or services that originate from a single party.

The Act allows for the registration of a collective mark by including a collective mark within the definition of trade mark.<sup>1</sup> A collective mark is defined in the Act as:<sup>2</sup>

collective trade mark means a sign capable of –

1. being represented graphically; and
2. distinguishing the goods or services of members of the association that is the owner of the sign from those of persons who are not members of the collective association.

The owner of a collective mark is the collective association in whose name the trade mark is registered.<sup>3</sup> A collective mark is registered in the name of a collective association in order to distinguish the goods produced or services provided by the members of the association from those of non-members.<sup>4</sup> The owner of the collective mark holds the title to the collective mark for the benefit of all members of the collective association.

A collective association as owner of a registered collective mark has the same rights as those given by a standard trade mark registration, including exclusive rights to use the mark in respect of the goods or services for which it is registered.<sup>5</sup> Any member of the collective association has, along with the collective association, the right to use the mark in respect of those goods or services.<sup>6</sup>

Use in relation to a collective mark includes use by a member of the collective association.<sup>7</sup> Members of the collective association do not have the right to exclude any other members of the association from using the mark in respect of goods produced or services provided by the other members.<sup>8</sup>

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#### Footnotes

<sup>1</sup> See the definition of ‘trade mark’ under section 5(1) of the Trade Marks Act 2002.

<sup>2</sup> Section 5(1) of the Trade Marks Act 2002.

<sup>3</sup> See definition of ‘owner’ under section 5(1) of the Trade Marks Act 2002.

<sup>4</sup> Section 15 of the Trade Marks Act 2002.

<sup>5</sup> Sections 10(1)(a) and 10(2)(a) of the Trade Marks Act 2002.

<sup>6</sup> Section 10(2)(a) of the Trade Marks Act 2002.

<sup>7</sup> Section 7(1)(d) of the Trade Marks Act 2002.

<sup>8</sup> Section 10(2)(b) of the Trade Marks Act 2002.

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### 3. Application for registration of a collective trade mark

An application to register a collective mark may be made in the same way as a standard trade mark application: on paper, or online.

An application may be made in one or more classes in a single application. Where the applicant files a multi-class application, the prescribed fee must be included for each class in which registration is sought.<sup>10</sup>

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#### Footnote

<sup>10</sup> Regulation 41(1)(a) of the Trade Marks Regulations 2003.

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## 3.1 Forms

Where an application is made on paper, the Commissioner will accept any manner of written communication that contains the mandatory filing requirements under the Act. IPONZ has provided an example of the application form in Appendix 1. The form simply illustrates one format and is not the only format that will be acceptable.

## 3.2 Filing locations

<sup>11</sup>An application may be made through our [online correspondence facility](#), which is available everyday, 24 hours a day.

Alternatively, a paper application may be filed between 8.30 am and 5 pm, Monday to Friday (not including public holidays). For our postal details please see [contact us](#).

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### Footnote

<sup>11</sup> IPONZ Newsletter February 2007. Please note, the “Late Filing Box” facility (where clients could deposit correspondence after business hours in Lower Hutt) was discontinued on 15 February 2007.

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## 3.3 Prescribed fees

The application fee may be paid with cash, cheque, direct debit or credit card. Where payment is made on-line by way of direct debiting or credit card, the on-line application will be considered to be accompanied by the prescribed fee as at the date the on-line application is made and the payment details are submitted and accepted.<sup>12</sup>

The prescribed fee for filing an application for a collective mark registration in a single class is NZ\$100.00 (plus GST). The fee for each additional class is NZ\$100.00 (plus GST).<sup>13</sup>

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### Footnotes

<sup>12</sup> Under regulation 170 of the Trade Marks Regulations 2003, the Commissioner has the discretion to choose the form of payment that will be accepted.

<sup>13</sup> Schedule 1 to the Trade Marks Regulations 2004.

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## 4. Mandatory filing requirements

An application for registration of a collective mark is, in the main, dealt with in the same way as an application for a standard trade mark and is subject to virtually the same eligibility criteria. Every application is checked to ensure that it meets the mandatory filing requirements as provided in the Act and the Regulations.

An application to register a collective mark must comply with the mandatory requirements set out in regulations 41 and 42 of the Regulations.<sup>14</sup> An application to register a collective mark must contain the following information:<sup>15</sup>

1. The name of the applicant;

2. An address for service in New Zealand;
3. A clear representation of the collective mark;
4. For a series of collective marks, a clear representation of each mark in the series; and
5. The goods and services for which registration is required.

An application will only be processed and a filing date assigned, when the mandatory filing requirements have been met.<sup>16</sup> Where an application does not contain the mandatory filing requirements, an application number and a filing date will not be allocated. The application fee will be refunded and, if the applicant wishes to obtain registration of the trade mark, the applicant will be required to file the application again with the required information.

For more information on the mandatory filing requirements, please refer to the relevant section in the Practice Guideline on The Application Process.

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#### Footnotes

<sup>14</sup> Regulation 59(a) of the Trade Marks Regulations 2004.

<sup>15</sup> Regulation 42 of the Trade Marks Regulations 2003.

<sup>16</sup> See regulation 41(2) of the Trade Marks Regulations 2003.

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## 5. General examination

A collective mark application is examined in the same way as a standard trade mark application to determine whether it complies with the requirements of the Act.<sup>17</sup> Under section 13(2) of the Act, a trade mark is registrable where:

- The application is made in accordance with the Act;
- All prescribed fees have been paid in respect of the application; and
- The Commissioner is satisfied that there are no absolute or relative grounds that would prevent the registration of the trade mark.

However, when examining a collective mark, the Examiner must take into account the additional requirements under regulations 44 and 59 of the Regulations.

The examination of a collective mark must also be performed in light of the nature of collective marks as provided for in sections 5 and 15 of the Act. Particular considerations under section 18 and section 25 of the Act relevant to collective marks are discussed below.

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#### Footnote

<sup>17</sup> Section 39 of the Trade Marks Act 2002.

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### 5.1 Mandatory acceptance requirements

A collective mark application must meet the mandatory acceptance requirements set out in regulation 44 of the Regulations.<sup>18</sup> The Examiner may also require further information to be provided to assist in the examination of the application.<sup>19</sup>

For more information on the mandatory acceptance requirements that would prevent the acceptance of the collective mark for registration, please refer to the relevant section of the Practice Guideline on The Application Process.

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## Footnotes

<sup>18</sup> See section 208(3)(a) of the Trade Marks Act 2002.

<sup>19</sup> See section 208(3)(b) of the Trade Marks Act 2002.

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## 5.2 Prescribed fees

Before an application to register a collective mark can be accepted, the prescribed fee must have been paid in respect of the application. Where additional classes are requested after the date of application, each additional class is subject to an additional class fee.<sup>20</sup>

Although the fee for an additional class is not essential for filing date purposes, payment must be made when filing the application for an additional class.<sup>21</sup>

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## Footnotes

<sup>20</sup> Regulation 43(2)(b) of the Trade Marks Regulations 2003.

<sup>21</sup> Additional classes may only be added within 1 month of the application. See regulation 43(2)(a) of the Trade Marks Regulations 2003.

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## 5.3 Absolute grounds preventing registration

The Commissioner must be satisfied that there are no absolute grounds that would prevent the registration of a collective mark.<sup>22</sup> The absolute grounds for not registering a collective mark are set out in sections 17 to 21 of the Act and concern the nature of the mark itself, its ability to distinguish the goods produced or services provided by the members of the association from those of non-members, and other public policy considerations.

A collective mark application is examined in the same way as a standard trade mark application to determine whether it complies with the absolute grounds of refusal in the Act. For more information on absolute grounds that would prevent the registration of a collective mark, please refer to the following Practice Guidelines:

- Absolute Grounds: General
  - Absolute Grounds: Distinctiveness
  - Absolute Grounds: Chemical Names
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## Footnote

<sup>22</sup> Section 13(2) of the Trade marks Act 2002. The absolute and relative grounds are set out in Part 2 of the Act.

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### 5.3.1 Additional distinctiveness considerations

When considering eligibility under section 18 of the Act, the Examiner should take into account section 15 of the Act and the definition of a

collective mark under section 5 (1) of the Act.

In particular, the Examiner should assess the distinctiveness requirement set out in section 18(1)(b) of the Act by keeping in mind the nature of the collective mark association, in that the mark must be capable of distinguishing the goods and services from a member of a collective association from those of a non-member, as opposed to the goods and services of a single party.

## 5.4 Relative grounds preventing registration

The Commissioner must be satisfied that there are no relative grounds that would prevent the registration of the collective mark.<sup>23</sup> The relative grounds for not registering a trade mark are concerned with conflict between the applicant and rights held by other persons, entities or traders and are set out in sections 22 to 30 of the Act.

A collective mark application is examined in the same way as a standard trade mark application to determine whether it complies with the relative grounds of refusal in the Act. For more information on relative grounds that would prevent the registration of a collective mark, please refer to the following Practice Guidelines:

- Relative Grounds: Prescribed Words and Abbreviations
- Relative Grounds: Names or Representations of Persons
- Relative Grounds: Representations of the Royal Family
- Relative Grounds: Identical and Similar Marks
- Relative Grounds: Flags, Armorial Bearings, State Emblems and similar

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Footnote

<sup>23</sup> Section 13(2) of the Trade Marks Act 2002. The absolute and relative grounds are set out in Part 2 of the Act.

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### 5.4.1 Additional identical and similar mark considerations

When considering potential citations of identical and/or similar marks, under section 25 of the Act, the Examiner should take into account section 15 of the Act and the definition of a collective mark under section 5 (1) of the Act. In particular, when searching the register the Examiner needs to keep in mind that the function of certification, collective and standard trade marks are different.

A standard trade mark distinguishes goods and services that originate from a single party whereas a collective mark distinguishes the origin of goods and services from a member of an association from those of a non member. A certification trade mark does not indicate origin. Rather, it indicates that some characteristic of the goods or services provided has been certified by the owner of the mark, who does not trade in the concerned goods or services.

Where an Examiner finds an identical or similar mark on the register for the same or similar goods or services, they should take this as prima facie evidence that the mark cannot serve the function specified for it under the Act. The Examiner should raise a concern that the mark on the Register has priority over the applicant's mark.

## 5.5 Specifications

Specifications and amendments to specifications for collective marks are dealt with in the same manner as a standard trade mark. For more information on classification and specifications, please refer to the Practice Guideline on Classification and Specifications.

## 5.6 Series

An application for a series of collective marks is dealt with in the same manner as a standard trade mark. For more information on series marks, please refer to the Practice Guideline on Series Marks.

Where an application for a series of collective marks covers various types of membership such as “Fellow of...”, Member of... or “Associate of...”, IPONZ considers that these do not form a material part of the mark itself.

## 6. Additional examination requirements

The Examiner must take into account the additional requirements for collective marks provided for under regulations 44 and 59 of the Regulations. The following requirements must be satisfied before a collective mark may be accepted:

- An indication that the application is for a collective mark:<sup>[24](#)</sup>
- A declaration that the applicant is a collective association as defined in the Act.<sup>[25](#)</sup>

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### Footnotes

<sup>24</sup> Regulation 44(b) of the Trade Marks Regulations 2003.

<sup>25</sup> Regulation 59(b) of the Trade Marks Regulations 2003.

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## 6.1 Indication of a collective mark

The applicant for a collective mark must indicate that the application is for a collective mark. It is not mandatory that this indication is made at the date of application; however, the mark will not proceed to acceptance until this requirement is satisfied.<sup>[26](#)</sup>

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### Footnotes

<sup>26</sup> Regulation 44 of the Trade Marks Regulations 2003.

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## 6.2 Declaration by collective association

A collective mark must be registered in the name of a collective association.<sup>[27](#)</sup> Therefore, only a collective association may apply to register as the owner of a collective mark.

A collective association is defined in the Act as follows:<sup>[28](#)</sup>

collective association means a body (whether incorporated or not) that has or is able to have members, and is --

- (a) constituted for the joint benefit of its members for the time being; and
- (b) so constituted that its membership at any time can be ascertained.

An application for registration of a collective mark must include a declaration that the applicant is a collective association as defined in

section 5(1) of the Act.<sup>29</sup>

A statutory declaration is not required as a matter of course, but may be requested at the discretion of the Office. The applicant should supply the following information in the declaration:<sup>30</sup>

1. A statement that the collective association is constituted for the joint benefit of its members; and
2. A statement that the membership of the collective association may be ascertained at any time. This may include information such as:
  - Whether the association has a list of members;
  - Where the list of members list is held;
  - How often the list of members is updated;
  - If there are any conditions for use of the mark; and
  - Whether any such conditions for the use of the mark are the same as conditions for membership of the collective association.

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#### Footnotes

<sup>27</sup> Section 15 of the Trade Marks Act 2002.

<sup>28</sup>Section 5(1) of the Trade Marks Act 2002. See also the definition of ‘owner’ in section 5(1). Under the Act, the word ‘owner’ means, in relation to a registered collective mark, the collective association in whose name the mark is registered.

<sup>29</sup> Regulation 59(b) of the Trade Marks Regulations 2003.

<sup>30</sup> Section 5(1) of the Trade Marks Act 2002.

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## 7. Applications that do not comply with the Act

A collective mark application will be considered to be non-compliant with the requirements of the Act where any of the requirements set out in sections 13(2) and section 15 of the Act have not been met.

Where an application is not in order for immediate acceptance, a Compliance Report will issue setting out the deficiencies in the application that will need to be addressed before the application can proceed.

For more information on the procedure where applications do not comply with the Act, please refer to the relevant section in the Practice Guideline on The Application Process.

## 8. Amendments, alterations and corrections of error

An application for an amendment to a collective mark application or registration is dealt with in the same manner as a standard trade mark. For more information on amendments, alterations and corrections please refer to the following Practice Guidelines:

- Amendments to Trade Mark Applications
- Cancellation and Alteration of Registered Trade Marks
- Rectification of Registered Trade Marks

### 8.1 Correcting the nature of an application

<sup>31</sup>Applicants may request that the Commissioner correct an error or omission regarding the nature of the application.

A request to change the nature of a trade mark application (for example from a standard trade mark application to a collective or certification trade mark application, or vice versa) is not considered a correction that materially alters the meaning or scope of the application. Such a

request will therefore be allowed.

However, section 54 of the Act requires that the draft regulations must be submitted within six months of a certification trade mark application being filed. Therefore, an applicant will not be allowed to amend the nature of the mark from a standard trade mark or a collective trade mark, to a certification trade mark after the six month period has elapsed.

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Footnote

<sup>31</sup> Practice Guideline Amendment 2006/02, IPONZ Newsletter, May 2006.

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## 9. Divisions and merger

Collective marks can be divided and merged together in the same way as standard trade marks, as allowed for under the Regulations. For more information on division and merger, please refer to the Practice Guidelines on Division and the Practice Guidelines on Merger.

## 10. Post registration

A collective mark registration is subject to the same registration period as for a standard trade mark registration. For more information on renewals and restorations, please refer to the Practice Guidelines on Renewals and Restorations.

### 10.1 Licensees

The Act does not allow for the registration of licensees in respect of collective marks. The definition of trade mark in the Act specifically excludes the licensee provisions from collective marks.<sup>32</sup>

Therefore, the right to use a collective mark is limited to members of the association and the owner of the mark. A third party who is not a member of the association does not have any right to use the mark, regardless of the quality or characteristics of the goods or services which it supplies.

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Footnote

<sup>32</sup> Section 5(1) of the Trade Marks Act 2002.

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